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Paper 121

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

WILLIAM HARRIS,
CHRISTOPHER HUW HILL, and IAN EDWARD DAVID SMITH
(6,150,373),
Junior Party,

v.

ELLEN MYRA DOBRUSIN,
JAMES MARINO HAMBY, JAMES BERNARD KRAMER,
MEL CONRAD SCHROEDER, HOWARD DANIEL HOLLIS SHOWALTER,
PETER TOOGOOD, and SUSANNE A. TRUMPP-KALLMEYER
(09/623,737),
Senior Party.

Interference No. 104,798

Before SCHAFER, TORCZON, and NAGUMO, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

DECISION ON REHEARING

INTRODUCTION

Dobrusin was accorded the benefit of its international application under the Patent Cooperation Treaty [PCT] (Paper 1). Harris moved to attack the benefit accorded to Dobrusin (Paper 51) pursuant to 37 C.F.R. § 1.633(g).¹ Dobrusin opposed (Paper 75), in part, on the basis that it was automatically entitled to its PCT filing date as the effective filing date of the involved Dobrusin application. Harris replied that Rule 633(g) authorizes an attack on benefit accorded in the declaration (Paper 82). In its decision the Board analyzed the question in terms of the Patent Cooperation Treaty

¹ Rules in 37 C.F.R. part 1 are cited solely by section number without part number, e.g., Rule 633(g).

and of the practice of the United States Patent and Trademark Office [Office] as explained in the Manual of Patent Examining Procedure [MPEP]. The Board concluded that Dobrusin was entitled to its PCT filing date as a matter of law because its involved application was simply the national stage of the PCT application rather than a distinct application and consequently dismissed the motion (Paper 99 at 4-7). Although Harris filed a timely request for reconsideration (Paper 105) of parts of the decision, Harris did not seek reconsideration of the decision on its preliminary motion 6. After extensive post-decisional briefing, a judgment ultimately issued against Harris (Paper 117). Less than a week after the ultimate judgment issued, Harris again requested reconsideration (Paper 118), this time on the basis of the new decision of the Court of Appeals for the Federal Circuit [Federal Circuit] in Stevens v. Tamai, App. No. 03-1479 (Fed. Cir. 4 May 2004) [Stevens].

TIMELINESS

As an initial matter, we note Dobrusin's concern, citing Gustavsson v. Valentini, 25 USPQ2d 1401, 1408-09 (BPAI 1991),² that the request for reconsideration is untimely. Despite the entry of judgment, the Board retains jurisdiction to act in a case until judicial review is initiated, see, e.g., In re Graves, 69 F.3d 1147, 1149 n.4 & text, 36 USPQ2d 1697, 1698 n.4 & text (Fed. Cir. 1995), or until the time for seeking judicial review has expired, 35 U.S.C. 135(a); Rule 661. The time for seeking judicial review runs for at least sixty days from the final judgment. 35 U.S.C. 142. There is no indication that either party has sought judicial review.

² Not binding precedent under Standard Operating Procedure 2 (2000).

Harris brought the Stevens decision to our attention on 12 May 2004, eight days after the Federal Circuit rendered its decision. Thus, the facts of this case stand in considerable contrast to Gustavsson, in which the request for reconsideration was filed many months after both the decision to be reconsidered and the Federal Circuit decision (both in September 1989) had issued. Moreover, as Gustavsson notes, the question of whether to consider a belated request for reconsideration is left to the discretion of the decision maker. The much closer timing in the present case than in Gustavsson justifies a different exercising of discretion here.

REHEARING OF DECISION ON HARRIS PRELIMINARY MOTION 6

The original decision on Harris preliminary motion 6 provided the following explanation (Paper 99 at 5-7) for the decision to dismiss the motion:

Dobrusin does not specify whether it is relying on the statute or rule as of a particular year. In the absence of a reliance interest, the current law is applied. Singh v. Brake, 222 F.3d 1362, 1371, 55 USPQ2d 1673, 1679 (Fed. Cir. 2000). The current text of 35 U.S.C. 363 is:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

The statute refers to the "international application designating the United States", which means an application filed under the PCT specifying the United States as a country in which a patent is sought. 35 U.S.C. 351(a), (c) & (e). Under 35 U.S.C. 371, the national stage for the PCT application is "commenced" upon the satisfaction of certain formal requirements, including the payment of a fee and the submission of the inventor's oath. Despite the payment of a new fee and the submission of the oath at commencement of the national stage, the Office treats the international application and the national stage of the international application as a single application. As the Manual of Patent Examining Procedure (§ 1893.03(b)) puts it:

An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application.

The treaty itself (Article 11(3)) says:

[A]ny international application...accorded an international filing date shall have the effect of a regular national application in each designated State as of the international filing date, which date shall be considered to be the actual filing date in each designated State.

The consequence is that we do not have the power under 37 C.F.R. § 1.633(g) to provide Harris with the relief sought. Rule 633(g) provides:

A motion to attack the benefit accorded an opponent in the notice declaring the interference of the filing date of an earlier filed application.

Since the PCT application is not an earlier application, but rather a stage of the involved application, Rule 633(g) does not apply.

Harris very correctly urges (Paper 82) at that the benefit in question is not benefit in the 35 U.S.C. 119, 120, 121, and 365 sense (i.e., benefit for the purpose of establishing an effective filing date in support of patentability); rather it is than benefit for the purpose of establishing an anticipation (i.e., benefit for denying patentability) under 35 U.S.C. 102(g)(1). Unfortunately, this distinction does not help Harris in this instance. Since the PCT application and the involved case are the same application, there is no question of whether Dobrusin's involved application properly relates back to an earlier application. Congress could, and in one instance did, make an exception for the anticipation context. Section 363 specifically excepts 35 U.S.C. 102(e), which provides:

A person shall be entitled to a patent unless --

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Plainly Congress could have chosen to exempt § 102(g)(1). The fact that it did not do so strongly supports Dobrusin's contention that it is entitled to its PCT filing date automatically. E.g., Russello v. United States, 464 U.S. 16, 23 (1983) (noting the doctrine that inclusion in one section creates a presumption that omission elsewhere was intentional).

The designation of Dobrusin's PCT application as a "benefit" application was a legal error in the declaration. Harris preliminary motion 6 is DISMISSED as improper under 37 C.F.R. § 1.633(g).

APPLICABILITY OF STEVENS

Stevens involved a motion seeking benefit under Rule 633(f) of a foreign-filed PCT application, in which the original was filed in a foreign language. The applicant, Tamai, argued that it should have been accorded the benefit of its PCT application automatically. The court held there was nothing inconsistent between the PCT implementing statutes and the rules of the Office, which place requirements on a party seeking the benefit of an earlier application. In particular, the court held that Tamai's failure to place a certified translation of its foreign-language original PCT filing into evidence was a sufficient basis for denying Tamai the effect of its PCT filing date. See also Rule 647 (requiring translations be certified).

The court held that the Office may reasonably permit an inquiry (via interference motions) into the issue of benefit to a PCT filing. The court qualified its holding "that all of these rules appear to reflect a permissible exercise of the Office's authority" with the

observation "that Tamai presents no arguments to the contrary." Unlike the present case, the Stevens decision does not indicate that either the Board or the court had been briefed on USPTO practice under the PCT as explained in the MPEP. By this observation we do not suggest that the Stevens decision is somehow wrong or that the interference rules are contrary to the statute, but more prosaically that different arguments on different records lead to different results. In Stevens, Tamai moved for relief, failed to comply with a requirement under Rule 647³ to file a certified English translation of the original Japanese PCT filing, and consequently was denied relief. These facts are not our facts.

Unlike the Stevens facts, the present case involves a PCT application filed in the United States in English. There is no question of translation and thus no question of compliance with Rule 647. The parties agree that Dobrusin's PCT disclosure is the same at both the international and national stages (Paper 75 at 2, fact 19; admitted in Paper 82 at 1) so the identity of the original PCT filing is not at issue. As explained in the decision, on these facts, the PCT filing date is not just the effective filing date, but is the actual filing date, of the involved Dobrusin application. There is no "benefit" to the earlier PCT disclosure and hence no benefit to attack within the meaning of Rule 633(g).⁴

³ While a motion for benefit under Rule 633(f) provided the context in which the issue arose, Tamai ultimately lost for failing to comply with the translation certification requirement of Rule 647. Cf. 35 U.S.C. 371(c)(2) (requiring a translation of the international application) and 372(b) (authorizing the Director to require "verification" of the translation).

⁴ We need not, and do not, decide how a movant should properly attack formal deficiencies in the filing at the international stage of PCT application because it is not an issue in this case. Harris preliminary motion 6 attacks the substance of the Dobrusin international application, not the formalities of its filing.

At root, Stevens defers to the discretion of the Director of the United States Patent and Trademark Office in formulating procedural rules for interferences. The Commissioner for Patents has, through the MPEP, stated the practice in the patent examining operations with regard to PCT filing dates, a practice that is consistent with the statute. Enzo Biochem, Inc. v. Gen-Probe, Inc., 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002) (even when not binding, patent examining guidelines are entitled to notice to the extent they are consistent with the law). Our decision to remain consistent with the patent examining practice reflects due deference to the officer most directly involved in the administration of the PCT. This decision is consistent with both the letter and the spirit of Stevens.

This decision on rehearing does not change the outcome of the decision on Harris preliminary motion 6 or the ultimate judgment in the interference. No further requests for rehearing would be warranted.

DECISION

Upon consideration of the Harris second request for reconsideration and Dobrusin's opposition to the request, it is:

DECIDED that the relief Harris requests be DENIED.

RICHARD E. SCHAFER
Administrative Patent Judge

RICHARD TORCZON
Administrative Patent Judge

MARK NAGUMO
Administrative Patent Judge

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